

5-13-04

16164
Efw

Express Mail Label
No. EV 432653720 US

MTC 6647.2 (39-21(51844)C)
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Lennon et al.
Serial No. 09/926,521
Filed April 26, 2002
Confirmation No. 6864
For POTASSIUM GLYPHOSATE FORMULATIONS
Examiner S. Mark Clardy

Art Unit 1616

May 12, 2004

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450

SIR:

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

In accordance with 37 C.F.R. 1.97 and 1.98 and MPEP 609, and in compliance with the duty of disclosure set forth in 37 C.F.R. 1.56, Applicants provide the following for consideration by the Patent and Trademark Office in the above-entitled application and to be made of record therein:

- - - - -

1. An Affidavit and a Supplemental Affidavit were executed by Erhard J. Prill, Ph.D. on January 21, 1977 and March 3, 1977, respectively. These were submitted on or about January 31, 1977 and March 9, 1977, respectively, as part of the prosecution of U.S. Patent Application Serial No. 05/630,392, which was later abandoned in favor of Continuation Application Serial No. 06/355,931 (now U.S. Patent No. 4,405,531).

2. The undersigned first obtained copies of these affidavits when they were provided as attachments to a letter of July 14, 2003 from Mr. Michael J. Flibbert, Esq., acting on behalf of Syngenta Crop Protection, Inc. Additionally, these affidavits were referenced in a Declaratory Judgment Complaint filed on November 24, 2003 in the United States District Court for the District of Delaware by Syngenta Crop Protection, Inc. against Monsanto Company and Monsanto Technology, LLC, a copy of which was provided to the undersigned on the same day it was filed.

3. The affidavit executed by Dr. Prill on January 21, 1977 includes the following statements:

In 100 grams of water at 25°C., N-phosphonomethylglycine is soluble in the amount of 1.0 gram;

In 100 grams of water at 100°C., N-phosphonomethylglycine is soluble in the amount of 7.7 grams;

In 100 grams of water at 2°C., the mono-isopropylamine salt of N-phosphonomethylglycine is soluble in the amount of 138 grams;

In 100 grams of water at 12°C., the mono-isopropylamine salt of N-phosphonomethylglycine is soluble in the amount of 154 grams;

In 100 grams of water at 33°C., the mono-isopropylamine salt of N-phosphonomethylglycine is soluble in the amount of 184 grams.

4. The supplemental affidavit executed by Dr. Prill on March 3, 1977 includes the following statements:

In 100 parts by weight of water at 25°C., the mono-potassium salt of N-phosphonomethylglycine is soluble in the amount of 158 parts by weight;

In 100 parts by weight of water at 25°C., the mono(di-methylamine) salt of N-phosphonomethylglycine is soluble in an amount in excess of 200 parts by weight.

5. The July 14, 2003 letter from Mr. Flibbert includes the statement that the Prill affidavits were prepared and publicly disclosed by Monsanto in 1981. The letter further includes the following statement:

The Prill affidavits report specific solubility data generated by Monsanto for potassium glyphosate: "In 100 parts by weight of water at 25°C., the mono-potassium salt of N-phosphonomethylglycine is soluble in the amount of 158 parts by weight." The affidavits also contrast the high solubility of the potassium salt with the low solubility of the free acid of glyphosate: "In 100 grams of water at 25°C., N-phosphonomethylglycine is soluble in the amount of 1.0 gram." In addition, the affidavits show that the high solubility of the potassium salt is comparable to the high solubility of the isopropylamine salt: "In 100 grams of water at 12°C., the mono-isopropylamine salt of N-phosphonomethylglycine is soluble in the amount of 154 grams."

6. The Declaratory Judgment Complaint filed on November 24, 2003 includes the following statements:

49. The Prill affidavits reported the results of solubility testing conducted by Monsanto on various glyphosate compounds, including potassium glyphosate and the mono-isopropylamine salt of glyphosate ("IPA glyphosate"). The affidavits disclosed the high water-solubility of potassium glyphosate and the IPA glyphosate and contrasted these high water-solubilities with the low water-solubility of the corresponding glyphosate acid.

50. Specifically, the first Prill affidavit, dated January 21, 1977, reported the low water-solubility of the free acid of glyphosate: "In 100 grams of water at 25°C., N-phosphonomethylglycine is soluble in the amount of 1.0 gram." It also reported the high water-solubilities of IPA glyphosate at three different temperatures.

51. The second Prill affidavit, dated March 3, 1977, reported the high water-solubility of potassium glyphosate: "In 100 parts by weight of water at 25°C., the mono-potassium salt of N-phosphonomethylglycine is soluble in the amount of 158 parts by weight." This figure was comparable to the high water-solubilities of IPA glyphosate reported in the first Prill affidavit.

52. The disclosed solubility of 158 parts by weight of potassium glyphosate in 100 parts by weight of water, as reported in the second Prill affidavit, would correspond to approximately 61.3% by weight of potassium glyphosate or approximately 50% by weight glyphosate acid equivalent in water.

53. Persons skilled in the art would interpret the solubility data reported in the Prill affidavits as showing that the

potassium and IPA salts of glyphosate are highly water-soluble compared to glyphosate acid.

54. Persons skilled in the art would further conclude from these data that one could readily prepare concentrated aqueous solutions of potassium glyphosate, . . .

60. Immediately upon issuance of the Franz [4,405,531] patent on September 20, 1983, the entire prosecution history of the Franz '531 patent before the Patent Office, which included the Prill affidavits, became a public record. Any member of the public could then access and copy any portion of that prosecution history at the Patent Office during normal business hours, upon request.

61. Upon information and belief, the Prill affidavits also were publicly disclosed during the litigation between Monsanto and Stauffer relating to the Franz '531 patent in *Stauffer Chemical Co. v. Monsanto Co.*, No. 84-1660-C(4) (E.D. Miss. filed July 18, 1985).

7. The Prill affidavits are being provided in the interest of ensuring a full disclosure. However, it is respectfully submitted that none of the pending claims read on the compositions disclosed in the affidavits. It is further submitted that it has been held that a document in the file history of a United States patent is not a printed publication for purposes of what is now 35 U.S.C. §102(a)/(b); *Camp Bros. & Co. Inc. v. Portable Wagon Dump & Elevator Co.*, 251 F. 603, 607-608 (7th Cir. 1917), *cert. den.*, 248 U.S. 571 (1918). This is consistent with the principles for determining the availability of a document, such as a printed thesis, as a printed publication, which require indexing for retrieval by those concerned with the technical subject matter of the document; *In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986). Where public accessibility to a printed document is insufficient to qualify it as a printed publication, it perforce lacks the

Express Mail Label
No. EV 432653720 US

MTC 6647.2 (39-21(51844)C)
PATENT

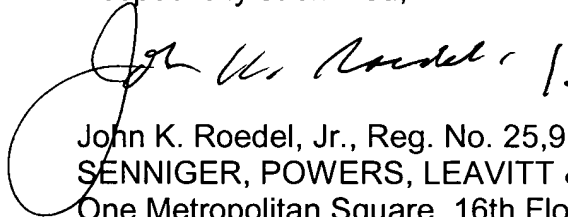
accessibility required for its contents to be deemed "known or used" in this country under 35 U.S.C. §102(a). Cf. *In re Schlitter*, 234 F.2d 882, 110 USPQ 304 (C.C.P.A. 1956); *In re Borst*, 345 F.2d 851, 145 USPQ 554 (C.C.P.A. 1965).

8. It is to be noted that these affidavits were made of record in *In Re Franz*, No. 81-611 (C.C.P.A. April 1, 1982), the record of which is understood to be on file with the U.S. Court of Appeals for the Federal Circuit. However, the undersigned has not succeeded in obtaining a copy of this unpublished court opinion from the clerk of the Federal Circuit.

- - - - -

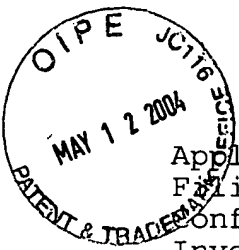
* A check in the amount of \$180.00 is enclosed to cover the fee specified in 37 C.F.R. §1.17(p) for submission of this Information Disclosure Statement.

Respectfully submitted,



John K. Roedel, Jr., Reg. No. 25,914
SENNIGER, POWERS, LEAVITT & ROEDEL
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

JKR/DEA/skd
*Enclosure



FEE TRANSMITTAL

Application Number 09/926,521
Filing Date April 26, 2002
Confirmation No. 6864
Inventors Lennon et al.
Group Art Unit 1616
Examiner Name S. Mark Clardy
Attorney Docket Number MTC 6647.2 (39-21(51844)C)

METHOD OF PAYMENT

1. ☐ The Commissioner is hereby authorized to charge the indicated fees to Deposit Account No. 19-1345.
☐ The Commissioner is hereby authorized to charge any additional fees required under 37 CFR 1.16 and 1.17 to Deposit Account No. 19-1345.
☐ Applicant claims small entity status.
2. ☒ Check Enclosed. The Commissioner is hereby authorized to charge any under payment or credit any over payment to Deposit Account No. 19-1345.

FEE CALCULATION

1. ☐ BASIC FILING FEE Subtotal (1) \$ _____
(Type: _____)
2. ☐ EXTRA CLAIM FEES Subtotal (2) \$ _____
Total Claims _____
Independent Claims _____
Multiple Dependent Claims _____
3. ☒ ADDITIONAL FEES Subtotal (3) \$ 180.00
☐ Surcharge - late filing fee or oath
☐ Surcharge - late provisional filing fee or cover sheet
☐ Extension for reply within _____ month
☐ Notice of Appeal
☐ Filing a Brief in Support of an appeal
☐ Request for ex parte Reexamination
☐ Petitions to the Commissioner
☒ Submission of Information Disclosure Statement
☐ Recording each patent assignment per property
☐ Request for Continued Examination
☐ Other: _____

TOTAL AMOUNT OF PAYMENT \$ 180.00

Derick E. Allen
Derick E. Allen, Reg. No. 43,468

5-12-04
Date

JKR/DEA/skd

Express Mail Label No. EV 432653720 US